

REMARKS

This Response, filed in reply to the Office Action dated June 8, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-13 and 15-18 remain pending in the application. Claims 10, 1-5, and 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamura et al (U.S. Patent 6,771,896, previously of record). Claims 10, 1-5, 16-18, 11-13, 6-9, 12 and 15 have been rejected under 35 U.S.C. § 103 as being unpatentable over Tamura in view of Dawe (previously of record) and Chui (U.S.P. 6,657,702, newly cited). Claim 15 has been rejected under 35 U.S.C. § 103 as being unpatentable over Tamura, Dawe and Chui and further in view of Cone and Narayanaswamy (both previously of record). Applicant respectfully submits the following comments in traversal of the prior art rejections.

As an initial matter, the Section 103 rejection over Tamura has been repeated and withdrawn over the course of the prosecution of this application. Applicant submits that the initial withdrawal of this rejection would indicate that the rejection had previously been successfully traversed, and the continued reliance on Tamura alone cannot support the rejection.

In relevant part, Tamura teaches at least two distinct embodiments. The embodiment of Fig. 3 relates to the receipt of order information for printing by a photofinisher. The embodiment of Figs. 9 and 12 relate to printing in a home environment. The Examiner cannot rely on a combination of distinct embodiments without a basis for the combination. Two embodiments in a single reference may not be combined absent specific teaching. In re Kramer, 18 USPQ2d

1415, 1416 (Fed. Cir. 1991); Ex parte Beuther, 71 USPQ2d 1313, 1316 (BPAI 2003). In the rejection of independent claims 10 and 1, the Examiner relies on the combined teachings of the photofinisher embodiment of Fig. 3 and the home printing system of Figs. 9 and 12. See page 3 of detailed action, second half of page. This is improper.

Relatedly, the Examiner's proffered motivation to provide a separate printer (130) for the thumbnail and the image data is to provide more efficient operation when cost is not a consideration. However, the printer system including 130 is provided in a home environment (Fig. 9). In such a home-use environment, the costs to a consumer would outweigh any marginal efficiencies gained because orders are processed for an individual household and not a large volume of users. The Examiner's citation to the printers 220 and 212 of Fig. 4 also do not support the rejection. This is because printer 212 prints a coupon but does not print a thumbnail. The printer 212 prints data such as order contents, charges, order number, user name, and finishing time for the order. To the extent that the Examiner contends that it would be obvious to print a thumbnail for purposes of order confirmation, it is noted that the coupon information can be correlated with the image data of a co-located camera (Fig. 4, element 100). Because the camera itself can generate a thumbnail, the confirmation can be efficiently made through the camera without generation of the thumbnail print. Applicant submits that the Examiner's motivation for modifying Tamura is not supportable, and claims 10 and 1 are patentable. Claims 2-5 and 16-18 are patentable based on their dependency.

With regard to the rejection over Tamura, Dawe and Chui, it was previously submitted that Dawe is not analogous art as it relates to computer order confirmation and not print ordering.

It was also previously submitted that the confirmation feature of Dawe would not necessitate the printing using a separate print device. The Examiner has yet to rebut either of these arguments. Therefore, Applicant maintains that Dawe may not be properly applied against the pending independent claims 1, 10, 6 and 11 and even if applied, does not make up for the deficiencies of Tamura.

The Examiner's reliance on Chui also does not support the rejection. The Examiner relies on col. 1, lines 57-65 to teach a confirmation. However, the cited portion merely indicates that individual images can be displayed and printed. Chui does not teach printing of a thumbnail image and further does not teach the printing of images and the thumbnail by separate printers. Therefore, claims 1 and 10 are patentable over the combination of Tamura, Dawe and Chui.

With regard to the rejection of claims 6 and 11, it is noted that these claims describe sending a thumbnail to the person placing the order. To the extent that Chui teaches sending thumbnail images by electronic means, these images are sent to a third party recipient who is not the orderer. See col. 21, lines 41-46. Therefore, the combination of Tamura, Dawe and Chui does not teach the features of claims 6 and 11.

The remaining claims are patentable based on their dependency. Applicant would also note that the additional references of Cone and Narayanaswamy do not make up for the above deficiencies.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/863,476

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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